# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/589,491 | 08/15/2006 | Meiko Masaki | 2006-1363A | 8260 |

52349          7590          06/18/2010
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| EXAMINER |
|---|
| BORSETTI, GREG |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2626 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/18/2010 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | Application No. | Applicant(s) | |
|---|---|---|---|
| **_Advisory Action_** **_Before the Filing of an Appeal Brief_** | _10/589,491_ | MASAKI ET AL. | |
| | **Examiner** | **Art Unit** | |
| | GREG A. BORSETTI | 2626 | |

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### _--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --_

THE REPLY FILED <u>09 June 2010</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

  a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

  b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

  (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

  (b)☐ They raise the issue of new matter (see NOTE below);

  (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

  (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

  The status of the claim(s) is (or will be) as follows:

  Claim(s) allowed: _____.

  Claim(s) objected to: _____.

  Claim(s) rejected: <u>_1-13_</u>.

  Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information _Disclosure Statement_(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: <u>Claims 1-13 are still rejected under Covell and Dagtas. It is noted that the amendments do change the scope of the claims, however since limitation were deleted the previous prior art references still apply. The additional amendment to claim 1 clarifying the instruction of the purpose does not change the scope of the claim.</u>

/Talivaldis Ivars Smits/
Primary Examiner, Art Unit 2626

/Greg A. Borsetti/
Examiner, Art Unit 2626

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Continuation of 11. does NOT place the application in condition for allowance because:

1.        The 35 USC 112 2nd paragraph rejection to claim 1 will be withdrawn in view of the amendments received 6/9/2010.

2.        Applicant argues "Claim 1 recites that the first reception unit receives an instruction, from the user, of a purpose of the AV content. Claim 1 does not restrict the first reception unit from receiving other instructions from the user. In other words, even though claim 1 recites that the first reception unit receives the instruction of the purpose and recites that the selecting is performed in accordance with the instruction of purpose and without receiving, from the user, an instruction different from the instruction of the purpose, claim 1 does not restrict the AV content processing device from receiving other instructions from the user and performing operations based on those instructions. Put another way, even though claim 1 recites that the selecting is performed without receiving an instruction other than the purpose instruction, claim 1 does not restrict the first reception unit from receiving other instructions from the user." (Remarks, Page 11, 2-3) The Examiner disagrees. Claim 1 is vague and non-descript about the "without receiving". Applicant contends it is associated with the "selecting", but the Examiner notes if can also be interpreted as the boundary correction unit determines whether the boundary is shifted... without receiving an instruction different from the instruction of the purpose. Therefore, a 112 2nd paragraph rejection is proper.

3.        Applicant further argues "Initially, the Applicants would like to thank the Examiner for the helpful Response to Arguments included in items 5-7 on pages 2-4 of the Office Action. However, the Applicants note that that last paragraph on page 3 of the Office Action states that "[i]n response to applicant's argument that the references fail to show certain features of applicant's invention", it is noted that the features upon which applicant relies (i.e ....without receiving, from the user, an instruction different from the instruction of the purpose ...) are not recited in the rejected claims." (Remarks, Page 12, 2) The Examiner notes that in the action (3/10/2010) is correct. At the time the action was written, claim listing (1/28/2010) was being considered which clearly added the claim language and was newly amended into the claim. At this point, no response was necessary about the claims in the arguments since they had not yet been rejected. They were, however, clearly considered in the rejection that followed. The argument is not persuasive.

4.        Applicant further argues "Thus, in view of the above, it is clear that Covell teaches that a user can select "surf" or "zap" in order to set certain conditions related to program/segment matching, but fails to disclose or suggest receiving, from a user, an instruction of a purpose, selected from reproduction and edit, of AV content and selecting, in accordance with the received instruction of the purpose and without receiving, from the user, an instruction different from the instruction of the purpose, whether the boundary_ is shifted in one of a direction causing the CM section to be short and a direction causing the CM section to be long, and correcting a content of the boundary_ information to cause the boundary to shift in accordance with the selected direction of the boundary shift, as recited in claim 1." (Remarks, Pages 13-14) The Examiner disagrees. As is contended in the most recent Office action, the boundary is shifted causing the CM section to be long or short without receiving from the user and instruction different from the instruction of the purpose. In the cited section (column 16, lines 33-45) the user selects "zap" and the sections may be extended or shortened automatically (without receiving from the user an instruction different from the instruction of the purpose). The argument is not persuasive.

5.        Applicant further argues "Thus, in view of the above, it is clear that Covell teaches that automatic extending/trimming of a previously recorded segment can be performed by matching the previously recorded segment to a newly received segment and adding appropriate portions of the newly received segment to the end or beginning of the previously recorded segment, but fails to disclose or suggest selecting (in accordance with the received instruction of the purpose and without receiving, from the user, an instruction different from the instruction of the purpose) whether the boundary is shifted in one of a direction causing the CM section to be short and a direction causing the CM section to be long, correcting a content of the boundary_ information to cause the boundary to shift in accordance with the selected direction of the boundary_ shift, and determining the boundary between the program section and the CM section of the AV content in accordance with the corrected boundary information, as recited in claim 1. In other words, Covell merely teaches automatically extending/trimming existing segments by adding new segments to the existing segments, if a "match" is found, which is completely different from determining and shifting boundaries between the program section and the CM section of the AV content, as required b claim 1." (Remarks, Pages 14-15) The Examiner disagrees. Extending/trimming section determines and shifts the boundaries between the program section and the CM section. The boundary is clearly detected and shifted based on whether a section is automatically extended or trimmed as shown in column 16, lines 33-45 of Covell. The argument is not persuasive.

6.        Applicant further argues "Moreover, the Applicants note that a result of the structure required by claim 1 is that the present invention intentionally shifts, in accordance with a function selected by a user, a border between a CM and a program, in order to improve usability. On the other hand, Covell performs CM detection based on matching (i.e., as described above, the surf/zap functions are for setting the conditions for the program matching), which is completely different from intentionally shifting, in accordance with an instruction of purpose selected by a user, the border between the CM and the program, so as to improve reliability of a detected border between the CM and the program, as required by claim 1." (Remarks, Page 15, 4) Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. .